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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
097293,455	04/16/99	DEBELIUS S	0275D-000247

MM71/0618
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EXAMINER
TAMAI, K

ART UNIT	PAPER NUMBER
2834	

DATE MAILED: 06/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/293,455
Filing Date: April 16, 1999
Appellant: DEBELIUS, STEPHEN A.

W.R. Duke Taylor
For Appellant

EXAMINER'S ANSWER

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This is in response to appellant's brief on appeal filed 4/30/01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct, but should refer to the specification by page and line number.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-21 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

<u>PATENT No.</u>	<u>INVENTOR</u>	<u>PUBLICATION DATE</u>
3,624,434	Dafler et al.	11/1971
3,829,722	Rosenthal, Jr. et al.	8/1974
4,801,252	Wrobel	1/1989

(10) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claims 1-4, 6-11, 13-18, 20, and 21 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 7. The rejections are repeated below for the convenience of the Board of Appeals.

1. Claims 1-4, 7-11, 14-18, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dafler(US 3,624,434) and Wrobel(US 4,801,252). Dafler teaches a stator 42 with a rotatable armature 50, with a commutator 58, with brushes 70 held within an endplate 18, with bearings 28/26 on both ends of the shaft, the bearings surrounded by a housing 20 integrally fixed with the end plate 18, the housing having a receiving bore with a stepped configuration, and a retainer 84 on the shaft to retain the bearing. Dafler teaches every aspect of the invention except the bearing having an enlarged portion for receiving the retainer and the bearing having a stepped configuration to receive the bearing. Wrobel teaches the equivalence of the retainer

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flush to the end of the shaft (figure 4) and abutting the enlarged portion of the bearing (figure 3) which opens to the end of the shaft. Wrobel teaches a bearing with a stepped outer surface which seats in the bearing housing 5. It would have been obvious to a person skilled in the art at the time of the invention to construct the motor of Dafler with the recessed bearing of Wrobel because it is within the ordinary skill in the art to choose between known equivalents and because the recessed bearing is taught to help position of the bearing on the shaft and within the housing, and with the stepped outer surface of the bearing two mate with the bearing housing, as taught by Wrobel.

2. Claims 6, 13, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dafler(US 3,624,434) and Wrobel(US 4,801,252), in further view of Rosenthal,Jr. et al.(Rosenthal)(US 3,829,722). Dafler and Wrobel teach every aspect of the invention except a washer between the bearing and the commutator. Rosenthal teaches a washer between the bearing and the commutator. It would have been obvious to a person skilled in the art at the time of the invention to construct the motor of Dafler and Wrobel with a washer between the bearing and the commutator because Rosenthal(figure 1) shows that such washers are known and used in the motor are and because it is obvious to a person skilled in the art that the washer acts as a buffer between the rotating and non-rotating parts.

(11) Response to Argument

The Applicant's has presented two arguments: 1. hindsight construction and 2. no motivation to combine, both of which are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). All the limitations are shown in the prior art, Wrobel and Dafler, a sleeve bearings are constructed with a smaller bore for the shaft and a larger bore for a retaining ring (figure 3). Therefore, the claimed invention is not based on hindsight, but rather the general knowledge in the art.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Wrobel teaches

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two equivalent means to mount a sleeve bearing in a housing. It is within the ordinary skill in the art to choose between known equivalents. Wrobel teaches motivation in that the bearing with the retainer during operation and reduces noise(col. 1, lines 12-22).

The Applicant's suggestion that the examiner is viewing only a portion of each reference is not persuasive. The rejection is not made against anyone single reference, but is based on the combined teachings of all three references. The Applicants overly broad claim limitations are clearly shown in references along with proper motivation as set forth in the Final Office Action dated 10/24/2000.

For the above reasons, it is believed that the rejections should be sustained.
Respectfully submitted,



Karl I. E. Tamai
Primary Examiner
Art Unit 2834

June 13, 2001

APPEAL CONFERENCE: 6/13/2001

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